

REMARKS

Claims 4 and 19 have been amended to address the rejections presented under 35 USC Section 112, which were directed only to the form, and not the substance, of the claims. Claim 9 has been amended to correct a grammatical error. Applicants submit that, in view of the amendments, all rejections presented under 35 USC Section 112 should now be withdrawn.

Claims 1 through 19 stand rejected under 35 USC Section 103(a) as being unpatentable over U.S. Patent No. 6,207,625 to Ogano et al. (hereinafter "the Ogano et al. patent"), in view of U.S. Patent No. 3,898,168 (incorrectly identified in the Office Action as 3,893,168) to Brehm (hereinafter "the Brehm patent") and U.S. Patent No. 3,876,550 to Holubec (hereinafter "the Holubec patent"). Claims 1 through 9 and 10 through 19 stand rejected under 35 USC Section 103(a) as being unpatentable over U.S. Patent No. 6,444,624 to Walker et al. (hereinafter "the Walker et al. patent"), in view of the Brehm patent and the Holubec patent. Applicants respectfully traverse these grounds for rejection.

This application is a Continuation-in-Part of U.S. Patent Application No. 10/191,017, now U.S. Patent No. 6,642,188. The claims of the present application are substantially identical to those granted in the parent case, except that, while the parent allowed for the use of any rust inhibitor, the claims of the present application require the use of a specific combination of rust inhibitors found to be particularly effective in lubricants formulated for use in four cycle outboard marine engines.

Applicants' invention is based on the discovery of a lubricating oil composition formulated for use in four cycle outboard marine engines. In particular, it has been found that a formulation which contains 15-1,000 ppm molybdenum as well as zinc dialkyldithiophosphate which contributes at least 1,200 ppm phosphorus to the oil, provides a lubricating oil which passes a number of tests considered highly relevant to use of the oil in an outboard marine engine, and the use of the specified rust inhibitor combination provides further benefit, in lubricants for outboard marine engines.. The amount of phosphorus present in the claimed lubricating oil compositions is considered relatively high. Applicants readily concede that each of the additives set forth in the

claim is a known additive and the invention lies in the combination of the additives and not in any novel additive per se.

The Walker et al. patent was cited during prosecution of the parent application. However, as was noted during said prosecution, Walker et al. were not dealing with the same problem faced by applicants, that is, formulating a lubricating oil composition suitable for use in a four-stroke outboard marine engine. In particular, the Walker et al. patent, while reciting in general a number of additives do not in particular note any advantage attributable to providing an oil containing at least 1200 ppm phosphorus derived from zinc dialkyldithiophosphate used in combination with an oil containing a molybdenum compound in an amount of 15-1,000 ppm as well as a metal detergent, 1 -3.25 wt.% of an ashless dispersant and a rust inhibitor, optionally a viscosity modifier, and the composition having a Noack volatility of less than 15%.

Applicants, in the parent application, provided comparative data to rebut any assertion that the claimed composition is merely a collection of known additives. The comparison oil tested in the examples of the parent application was similar to applicants' composition except that it contained 4.4 wt. % dispersant and does not have a molybdenum additive. In comparison, applicants' oil contains the claimed combination including dispersant within the claimed range of 1 to 3.25 wt. %, 50 ppm molybdenum and the relatively high amount of phosphorus; 1,450 ppm. This can be seen from the data in which applicants' formulation consistently passed a number of tests considered relevant to outboard marine engine oils while the comparison oil did not. There is no teaching or suggestion in Walker as would lead one to select the particular additives in the particular proportions in order to obtain the desired result.

The Ogano et al. patent, also cited against the parent application and distinguished over during the prosecution thereof, is also not relevant to the subject matter of applicants' invention. The Ogano et al. patent relates to a lubricant oil composition which prevents wear of diesel engines operating with large quantities of soot in their oil. It is particularly suitable for diesel engines equipped with an exhaust gas recirculation system. Outboard marine engines are a different category and are not diesel engines. While the Ogano et al. does in fact recite very broad ranges for the molybdenum and the ZDDP components in oil, there is no teaching in the specification that

would lead one to select the particular proportions set forth in applicants' claims and combine them with the other ingredients in order to provide optimized lubricants for outboard marine engines. Again, attention is invited to the comparative data presented in the parent application, which shows the criticality of the amounts claimed.

For the reasons presented above, the present claims would be distinguishable over the cited combination of prior art references, even if the Brehm patent and the Holubec patent suggested the specific combination of antirust agents now claimed, which they do not. The Brehm patent is directed to a lubricant composition containing, in combination, dispersant, ZDDP, an overbased magnesium sulfonate detergent, and an antirust agent that is an alkylphoxy polyoxy ethanol. The specified antirust agent of the Brehm patent is described as being capable of reducing the precipitation of magnesium carbonate particles from the detergent in oils contaminated with water. Combinations of antirust agents are not suggested and, as the use of a combination of antirust agents (assuming a constant total amount of antirust agent is used) would in practice reduce the amount of alkylphoxy polyoxy ethanol in the lubricant and would be counter to the teachings of the Brehm patent. The Holubec patent is directed to lubricating oil compositions containing a combination of an alkylene dithiocarbamate antioxidant and a hydrocarbon-substituted succinic anhydride antirust agent. The Holubec patent teaches that more than one rust inhibiting compound can be used, however, all rust inhibiting compounds in the mixtures of the Holubec patent are based on succinic anhydrides and thus, the Holubec patent could in no way suggest the combination of rust inhibitors now claimed. Further, neither the Brehm patent nor the Holubec patent is directed to lubricants used in marine engines and the teaching thereof would not necessarily be applicable to such lubricants.

Thus, the primary references fail to suggest the basic formulation of the present claims and the secondary references fail to suggest the claimed combination of rust inhibitors, which applicants have found to be particularly effective in the marine lubricants now claimed. Therefore, applicants submit that that all rejections premised on the combination of either the Walker et al. patent or the Ogano et al. patent, considered in view of the Brehm patent and the Holubec patent should be withdrawn.

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Claims 1 through 19 also stand rejected under the non-statutory ground of obviousness-type double patenting in view of U.S. Patent No. 6,642,188, considered alone, or in view of the Holubec patent., and claims 1 through 19 were further rejected under 35 USC Section 103(a) as being obvious over U.S. Patent No. 6,642,188. Applicants respectfully request that these grounds for rejection be held in abeyance until the present application is otherwise found to be in condition for allowance, at which time, applicants can file proof of common assignment at the time of invention, and a terminal disclaimer.

In view of the foregoing amendments and remarks, favorable action is courteously solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jacob M. Levine", written in a cursive style.

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